

REMARKS/ARGUMENTS

The claims are 43-45 and 62-68, with claims 34-42 and 46-61 having been withdrawn by the Examiner as directed to a non-elected invention. New claims 66-68 have been added, which correspond to claims 43-45 written in independent form but with the formula of claim 36 incorporated therein and excluding hydrogen and hydroxyl from the electron-donating groups R_4 and R_5 (and the proviso expressly excluding resorcinol). In addition, the specification has been amended at page 5 to expressly state that resorcinol is excluded in accordance with the proviso contained in the claims presented with Applicants' April 21, 2005 Preliminary Amendment filed when entering the national stage of this international application. Reconsideration is expressly requested.

Applicants wish to thank the Examiner for the courtesy of a telephone interview on October 3, 2008, the substance of which is set forth herein. In this connection, it is noted that an Interview Summary dated October 3, 2008 appears on the electronic PAIR records for this application which incorrectly indicates that the interview was "personal" instead of -- telephonic --.

In the Office Action dated September 8, 2008, claims 43-45 and 62-65 were rejected under 35 U.S.C. 112, first paragraph, because the specification while being enabling for a phenol or a 3-substituted phenol or a 3,5-disubstituted phenol was said not to reasonably provide enablement for the proviso that the 3-substituted phenol can not be resorcinol. The Examiner also noted that the specification at page 5, lines 2-9, disclosed the use of a 3,5-disubstituted phenol in that R_4 and R_5 each independently represent Hydrogen or hydroxyl group, such that in the case of R_4 and R_5 is hydrogen and R_4 and R_5 , respectively, is hydroxyl group, then a resorcinol was included in the formula.

At the interview, the rejections under 35 U.S.C. 112, first paragraph, was discussed. Although it was not considered necessary, Applicants' attorney also stated that if it would facilitate matters, the specification at page 5, would be amended to include the proviso that expressly excluded resorcinol, which was contained in the claims presented with the April 21, 2005 Preliminary Amendment filed when entering the national stage in order to conform the specification to the claims as presented in the April 21, 2005 Preliminary Amendment. No agreement was reached, and the Examiner suggested that he would consider Applicants' arguments made at the interview upon the filing of an amendment amending the specification.

In this connection, it is noted that the October 3, 2008 Interview Summary incorrectly refers to page 4 of the Specification when it is believed that page 5 was intended. Accordingly, in response, Applicants have amended page 5 of the specification herein to expressly state that resorcinol is excluded. In addition, Applicants have added new claims 66-68 similar to claims 43-45 but written in independent form, incorporating the subject matter of claim 36, and eliminating from the Markush group in claim 36 hydrogen and hydroxyl group for the electron-donating groups R₄ and R₅, and respectfully traverse the Examiner's rejection for the following reasons.

It is respectfully submitted that there is no question that the claims are adequately enabled and that all Applicants are doing is claiming less than the full range of their disclosure which they are entitled to do under *In re Johnson*, 558 F.2d 1008, 194 U.S.P.Q. 187 (CCPA 1977).

In *Johnson*, the Court of Customs and Patent Appeals upheld claims where two species were excluded from the claim because they had been lost in an interference proceeding. The Court said, 194 U.S.P.Q. at page 196:

"The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose and teach those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirements of § 112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute. All that happened here is that appellants narrowed their claims to avoid having them read on a lost interference count."

It is respectfully submitted that the situation is similar here with respect to the claims which depend directly or indirectly on claim 34 where resorcinol is expressly excluded by the proviso. As explained in Applicants' response filed June 12, 2008, the compound resorcinol was specifically omitted in order to avoid a possible formal overlapping.

It is respectfully submitted, moreover, that there is no question that the claims are sufficiently clear and that one skilled in the art would know how to make compounds that are not resorcinol from Applicants' disclosure. Indeed, the Examiner acknowledges in the Office Action that all compounds covered by the general formula set forth in claim 34 are sufficiently enabled.

New claims 66-68 are similar to claims 43-45 except that they incorporate the formula of claim 36 and the Markush group recited therein is limited so as not to recite hydrogen or hydroxyl, thereby precluding resorcinol. It is respectfully submitted that these claims are adequately supported by the specification as well and should be allowed.

Accordingly, it is respectfully submitted that all claims are fully supported by the original specification as filed, and Applicants respectfully request that the rejection under 35 U.S.C. 112, first paragraph, as being insufficiently enabled be withdrawn.

In summary, new claims 66-68 have been added, and the specification has been amended. A check in the amount of \$408.00 is enclosed for three additional independent claims and three additional total claims over those previously paid for. In view of the foregoing, it is respectfully requested that the claims be allowed and that this case be passed to issue.

Respectfully submitted,
Paolo BERT ET AL



COLLARD & ROE, P.C.
1077 Northern Boulevard
Roslyn, New York 11576
(516) 365-9802
FJD:djp

Frederick J. Dorchak, Reg. No. 29,298
Edward J. Callaghan, Reg. No. 46,594
Attorneys for Applicants

Enclosure: Check in the amount of \$408.00 (3 additional independent claims and 3 additional total claims)

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 8, 2009.



Amy Klein

R:\Patents\B\BERT ET AL - I PCT\Amendment 10-08.wpd